

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

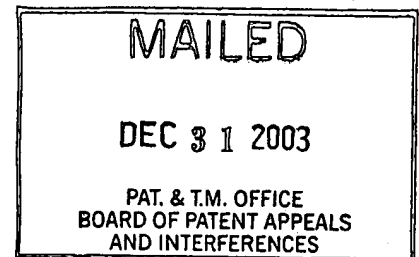
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARUNOBU KUSUMOTO and AKINORI SASAMOTO

Appeal No. 2003-1937
Application No. 09/522,296

ON BRIEF



Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16, 18 through 21, 28 and 29. Claim 17 stands objected to as being dependent upon a rejected base claim, but is indicated to be allowable if rewritten in independent form. Claims 22 through 27, which are the only other claims pending in the application, have been withdrawn from

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further consideration by the examiner as being directed to a non-elected invention.

As set forth on page 1 of the specification, appellants' invention is directed to a golf club head of the "metal wood" type having a structure wherein the strength of a shaft securing portion for securing a shaft to the body of the club head is increased and the balance of weight is improved and a manufacturing method therefor. Consistent with a restriction requirement issued by the examiner in a paper mailed July 5, 2001 (Paper No. 3), appellants have elected claims directed to the golf club head for prosecution in this application. Independent claims 1 and 28 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mills	3,819,181	Jun. 25, 1974
Motomiya	4,438,931	Mar. 27, 1984
Helmstetter	5,042,806	Aug. 27, 1991
Endo et al. (Endo)	5,556,097	Sep. 17, 1996
Take et al. (Take)	5,575,723	Nov. 19, 1996

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Minabe	5,961,394	Oct. 5, 1999
Drajan, Jr., et al. (Drajan)	6,033,318	Mar. 7, 2000
Mockridge (Published UK Patent Application)	GB 2 230 459	Oct. 24, 1990

Claims 1, 6 through 12, 14, 15, 18, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mockridge in view of Take, Helmstetter and Drajan.

Claims 1, 2, 3, 5 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo in view of Take, Helmstetter and Drajan.

Claims 1, 13, 20 and 21¹ stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mockridge in view of Take, Helmstetter and Drajan as applied above, and further in view of Minabe.

¹ We note that claim 21 is dependent from claim 2, which, in turn, is dependent from claim 1. Thus, the examiner's rejection of claim 21 over a combination of prior art references which is different from the combination of references applied in the rejection of claim 2, below, is somewhat confusing. Our disposition of the examiner's rejections on appeal makes this a moot issue for purposes of the appeal.

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Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mockridge in view of Take, Helmstetter and Drajan as applied to claim 1 above, and further in view of Motomiya.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mockridge in view of Take, Helmstetter and Drajan as applied to claim 1 above, and further in view of Mills.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer mailed November 15, 2002 (Paper No. 14) for the reasoning in support of the rejections, and to appellants' brief filed October 9, 2002 (Paper No. 13) and reply brief filed January 15, 2003 (Paper No. 15) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to

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the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first at the examiner's rejection of claims 1, 6 through 12, 14, 15, 18, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Mockridge in view of Take, Helmstetter and Drajan, we note that on pages 4-5 of the answer the examiner has urged that Mockridge differs from the claimed invention in that Mockridge "does not show a shaft-securing portion homogeneously formed as part of the outer shell structure." To account for the above-noted difference, the examiner has looked to the patents of Take, Helmstetter and Drajan, from which the examiner has apparently derived teachings which "show it to be old in the art to fabricate the shaft-securing portion, i.e., the hosel, as part of the shell structure to form a unitary part."

Based on the combined teachings of the above-noted references, the examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made "to modify the golf club head of Mockridge by casting the shaft-securing portion homogeneously

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with the remaining shell portion from a top portion to a bottom portion of the shell, the motivation being to simply provide the added benefits [sic] enhanced rigidity throughout the shaft securing means." The examiner also asserts that

the selection by the clubmaker to assemble the shell in Mockridge through either the mating of diverse parts or through the casting of a single piece would have been obvious at the time the invention was made, as it has been held to be within the level of one of ordinary skill in the art to make integral that which has been heretofore been made in separate parts.

Appellants argue (brief, pages 7-9) that the examiner has failed to establish a *prima facie* case of obviousness, because there would be no reason or motivation for one skilled in the art to combine the disclosures of any of the applied prior art references in the manner suggested by the examiner or in a manner which would result in the claimed subject matter. In particular, appellants contend that Take expressly teaches away from a shaft-securing portion like that claimed in the present application, because it states in column 4, lines 35-40, that the portion of shaft (29) disposed in the club head body (45) is supported at two points by shaft support portions (51) and (53), and that such shaft portion is "not supported around its entire periphery by a peripheral wall . . . integral with the head body." A similar

disclosure is found in column 5, lines 17-25, regarding the embodiment of Figure 3 in the Take patent. In the reply brief, appellants further contend that the combinations posited by the examiner are the result of hindsight reconstruction based on appellants' own disclosure and not on any disclosure or suggestion of the desirability of making such changes in the club head structure of Mockridge found in the applied references themselves.²

Having considered the applied patents to Mockridge, Take, Helmstetter and Drajan, we share appellants' view that there is no motivation, teaching or suggestion in the applied references, whether considered individually or collectively, for the examiner's proposed combinations thereof. In our opinion, appellants have correctly assessed the teachings of Take, and correctly concluded that this patent teaches away from a club head construction like that claimed by appellants. We also agree with appellants that the examiner has used impermissible hindsight derived from appellants' own teachings in seeking to

² We have understood appellants' many references to "Drajan '033" in the brief and reply brief as being to Drajan '318, the reference applied by the examiner in the rejections on appeal.

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combine selected portions of the applied references to Take, Helmstetter and Drajan, and/or broad concepts contained therein, with the distinctly different golf club head arrangement shown in Mockridge in an effort to arrive at appellants' claimed subject matter. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. That same Court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the invention as a whole as 35 U.S.C. § 103 requires, as we believe the examiner has done in the present case. See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

Regarding the examiner's attempt to dispose of appellants' claimed subject matter as being obvious because it has been held to be within the level of one of ordinary skill in the art to make integral that which has heretofore been made in separate

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parts, we see no basis whatsoever for any such pigeonhole approach in this case, and remind the examiner that the mere fact that some prior art reference may be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir 1984). Here, the prior art relied upon by the examiner contains no such suggestion and the examiner is merely relying on speculation and conjecture alone to support the rejection.

Since we have determined that the teachings and suggestions found in Mockridge, Take, Helmstetter and Drajan, as applied by the examiner, would not have made the golf club head of claims 1, 6 through 12, 14, 15, 18, 28 and 29 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

As for the examiner's rejection of claims 1, 13, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Mockridge in view of Take, Helmstetter, Drajan and Minabe; that of claims 2

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and 4 based on Mockridge, Take, Helmstetter, Drajan and Motomiya; and the rejection of claim 19 under 35 U.S.C. § 103(a) relying on Mockridge, Take, Helmstetter, Drajan and Mills, we have additionally reviewed the patents to Minabe, Motomiya and Mills, but find nothing therein that provides for that which we have indicated above to be lacking in the examiner's basic combination of Mockridge in view of Take, Helmstetter and Drajan. Accordingly, the examiner's rejections of claims 1, 2, 4, 13, 19, 20 and 21 under 35 U.S.C. § 103(a) will likewise not be sustained.

The last of the examiner's rejections for our consideration on appeal is that of claims 1, 2, 3, 5 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Endo in view of Take, Helmstetter and Drajan. In this instance, the examiner has looked to the multi-piece golf club head of Endo, which is similar to that seen in appellants' "Prior Art" Figures 28-29, and urged that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to modify the golf club head of Endo "by casting the shaft securing portion homogeneously with the remaining shell portion from a top portion to a bottom portion of the shell, the motivation being to simply

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provide the added benefits [sic, of] enhanced rigidity throughout the shaft securing means" (answer, page 7). The examiner has also urged that the selection by the club maker to assemble the shell in Endo through either the mating of diverse parts or through the casting of a single piece would have been obvious at the time the invention was made, because it has been held to be within the level of one of ordinary skill in the art to make integral that which has heretofore been made in separate parts.

Our reasons stated above for not sustaining the examiner's rejection of claims 1, 6 through 12, 14, 15, 18, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Mockridge in view of Take, Helmstetter and Drajan, apply equally well here, where we consider that the examiner has again relied upon impermissible hindsight derived from appellants' own teachings in seeking to combine selected portions of the applied references to Take, Helmstetter and Drajan, and/or broad concepts contained therein, with the distinctly different golf club head arrangement shown in Endo in an effort to arrive at appellants' claimed subject matter. We also again find the examiner's attempt to dispose of appellants' claimed subject matter as being obvious because it has been held to be within the level of one of ordinary skill in

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the art to make integral that which has heretofore been made in separate parts, to be untenable and based entirely on speculation and conjecture. Thus, the examiner's rejection of claims 1, 2, 3, 5 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Endo in view of Take, Helmstetter and Drajan will not be sustained.

In light of the foregoing, the decision of the examiner to reject claims 1 through 16, 18 through 21, 28 and 29 of the present application under 35 U.S.C. § 103(a) is reversed.

In addition to the above determinations, we REMAND this application to the examiner for a consideration of the differing scopes of independent claims 1 and 28 on appeal, and for further consideration of certain prior art references in the record, with the object being for the examiner to consider whether rejections of the claims on appeal based on such prior art references might be appropriate.

In particular, we direct the examiner's attention to the disclosure in Mockridge at page 1, lines 20-22 and in claims 1 and 4 thereof, which appears to describe an embodiment of the

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"metal wood" club head therein where the socket or shaft securing portion (19) is cast integrally with the first hollow shell part (11) and extends to and is secured to a separately formed sole plate member (18) by welding. We also point out that the portion designated by reference character (15) in Mockridge is said to be the "bottom" of the club head and would appear to be properly termed a "sole portion" (emphasis added) integrally formed as part of the shell part (11). Thus, the unillustrated embodiment of the golf club head in Mockridge would appear to be fully responsive to that set forth in appellants' claim 1 on appeal, even though the shaft securing portion is not integrally cast with a connection to the sole plate (18). The examiner should also consider the unillustrated embodiment of Mockridge with respect to the golf club head defined in claim 28 on appeal.

NO!

In addition, we direct the examiner's attention to 1) Prior Art Figure 28 of the present application and the description thereof in the paragraph bridging pages 4 and 5 of appellants' specification as being from Japanese Patent Publication No. 10-295857; and 2) Prior Art Figure 5 of Take et al. (US Patent No. 5,575,723) and the description thereof in column 1 of that patent as being disclosed in Japanese Patent Unexamined

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Publication No. 5-96013, for consideration of the club head structures therein vis-a-vis that defined in appellants' claim 1 on appeal. The examiner should consider whether one of ordinary skill in the art would understand the integral molding of the hollow metal shell structures mentioned in these two references to connote "casting" and, if not, to determine if forming such hollow shell structures by casting would have been obvious to one of ordinary skill in the art at the time of appellants' invention.

As a further point, we direct the examiner's attention to the applied Drajan patent, with particular reference to a properly construed claim 28 on appeal, which claim is readable on the embodiment of appellants' invention seen in Figures 8-12 of the application, and appears to be readable on the golf club head seen in Figure 1 of Drajan.


Our final issue for the examiner to consider on REMAND is whether a rejection of claims 28 and 29 should be entered under 35 U.S.C. § 112, second paragraph, as being indefinite. In that regard, we note that we find no proper antecedent basis in claim 28 for the reference in line 3 of the claim to "a top portion."

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A top portion of what? In addition, it would appear that the recitation of "a sole portion fixed to said top portion" in claim 28 is also ambiguous, as is the recitation in claim 29 of a joining hole being provided "with the other of said top portion and said sole portion."

REVERSED AND REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge

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